

REMARKS

STATUS OF THE CLAIMS:

Claims 22-39 are pending. Claims 22-39 are rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 22, 26-27, 29-31, and 35 are rejected under 35 USC 103(a) as allegedly being unpatentable over USPN 6,311,011 issued to Kuroda (*Kuroda*) in view of USPN 5,991,832 issued to Sato *et al.* (*Sato*) and USPN 6,430,363 issued to Sasaki *et al.* (*Sasaki*). Claims 23-24, 32-33, and 36-37 are rejected as allegedly being unpatentable over *Kuroda* in view of *Sato* and *Sasaki* and further in view of USPN 5,990,927 issued to Hedricks *et al.* (*Hedricks*). Applicants respectfully traverse all rejections.

REJECTIONS UNDER 35 USC 112, FIRST PARAGRAPH

The Examiner deems the use of the electronic program guide to control playback commands as not being enabled because the specification as originally filed shows instead that playback commands are controlled by a user interface. Applicants take no position regarding whether controlling playback commands with an electronic program guide is enabled, but in order to advance prosecution, Applicants have amended Claims 22 and 35 to remove any reference to the electronic program guide being used to control playback commands. Instead, Claim 22, as amended, recites "wherein the user interface controls playback commands of the video data management system and the playback commands are usable while the external video data stream is being recorded" and Claim 35, as amended, recited "controlling playback commands in response to the user input, wherein the playback commands are usable while the external video data stream is being recorded." Applicants respectfully submit that the amended language is clearly enabled by the specification as originally filed, and accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

REJECTION UNDER 35 USC 103(a):

As noted, independent Claims 22 and 35 each recite that “the playback commands are usable while the external video data stream is being recorded.” Claim 22 also recites that a video data management system “routes the selected portion of the streaming video data to the external hard disk drive via the isochronous interface.” Claims 35 also recites “routing at least a portion of the streaming video data to the external hard disk drive via the isochronous interface.” As Applicants have previously noted, the electronic programming guide of *Sato* does not disclose the quoted limitation regarding the playback commands, because the storage medium used in *Sato* is a sequential storage medium that does not allow playback commands and *Sato* specifically teaches that the electronic programming guide should present a uniform interface. The Examiner notes, however, that the newly-cited *Kuroda* reference discloses the use of an electronic program guide with a video storage device and the newly-cited *Sasaki* reference discloses video recording with a hard disk drive using playback commands, as does *Goldwasser*. The Examiner argues that the combination of all of these features assembled from these numerous references would have somehow been combined by one skilled in the art to produce the invention claimed in Claims 22 and 35. Applicants respectfully submit that, on the contrary, the newly-cited references suffer from the same deficiencies as the previous references, in that they do not show a video recording system that routes a selected portion of streaming video data to an external hard disk drive via an isochronous interface and enables playback commands to be usable while an external video stream is being recorded. Nor has the Examiner provided a motivation for one skilled in the art to create such a combination, even on the counterfactual assumption that the elements of that combination were shown.

Perhaps the clearest demonstration that the proposed combination is not shown is that *Kuroda* includes several of the elements but explicitly rejects the workability of the proposed combination. In numerous places, *Kuroda* explicitly teaches the use of a hard disk drive (HDD) as a temporary *internal* video storage device 103 (see, e.g., Fig.

5; Fig. 8; col. 4, lines 26-28; col. 5, lines 12-15; col. 12, lines 28-36, lines 45-49). *Kuroda* clearly contemplates the random access medium as a video storage medium, but *Kuroda* expressly does not perform the step of “rout[ing] the selected portion of the streaming video data to the external hard disk drive via the isochronous interface,” nor does any other electronic program guide that enables the use of playback commands (see, e.g., *Sato*). The reason is stated explicitly in *Kuroda*; the bus load for playback commands was understood to be excessive (see, e.g., col. 5, lines 50-52; col. 6, lines 30-40). Moreover, like *Sato*, the purpose of the video recording system of *Kuroda* was expressly that it “unifies interface [*sic*] of a plurality of storage devices by recording in the storage devices *via the built-in storage device* [emphasis added], so that the viewer of the video recorder is free to select starting time and a storage device to record contents” (see, e.g., col. 12, lines 47-51). Using an external hard drive for simultaneous video recording and playback commands would have been understood to be unworkable in this object, which is why neither *Kuroda* nor *Sato* show routing an external video stream to an *external* hard disk drive via an isochronous interface for recording while playback commands are usable.

Moreover, because of the stated purpose of both *Kuroda* and *Sato*, the proposed modification would render either unsuitable for their purpose, which means that there is no motivation to make the proposed combination (MPEP 2143.01(V)). *Kuroda* expressly states that its purpose is to unify interfaces by recording *only* via a built-in storage device. Routing to an external storage device contradicts the express purpose of *Kuroda*. Applicants have repeatedly noted the same deficiency with respect to *Sato*, which intended to provide a uniform interface and would accordingly teach away from playback commands used with the programming guide.

In summary, the mere showing that hard disk drives can be used to record video with playback commands, as in *Goldwasser*, *Sasaki*, and *Kuroda*, does not show “routing at least a portion of the streaming video data to the *external* hard disk drive via the isochronous interface” in combination with the limitation that “the playback commands are usable while the external video data stream is being recorded.” None of the cited references teach, suggest, disclose or describe routing the video stream to an

external hard disk drive. Indeed, the proposed combinations with *Kuroda* and *Sato* render both of those video recording systems managing external video storage unsuitable for their stated purpose, which is why neither of them show routing an external video stream to an *external* hard disk drive, much less using playback commands while the external video stream is recorded. The Examiner has yet to cite any video data management system with an electronic program guide that also routes a video stream via an isochronous interface to an external hard disk drive, wherein playback commands are enabled during recording of the video stream. For at least the foregoing reasons, Claim 22, Claim 35, and the remaining pending claims (all of which depend directly or indirectly on either Claim 22 or Claim 35) are not rendered obvious by the cited references. Accordingly, Applicants respectfully request reconsideration and allowance of all pending claims.

CONCLUSION

In view of the foregoing amendments and/or remarks, Applicant respectfully submits that the pending claims are now in condition for allowance and requests reconsideration of the rejections. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1209.

Respectfully submitted,

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